

Appl. No. : 09/738,372
Filed : December 15, 2000

REMARKS

REJECTIONS UNDER 35 USC § 112

The Examiner rejected all of the claims as “omitting essential steps,” citing MPEP § 2172.01. The Examiner listed the “omitted steps” as 1) pumping a gain medium within a resonant Fabry-Perot laser cavity; 2) generating Q-switched mode-locked laser pulses using a saturable absorber located within said resonant Fabry-Perot optical cavity; 3) absorbing said Q-switched laser pulses by insertion of a two-photon absorber within the said resonant Fabry-Perot optical cavity; and 4) outputting a cw mode-locked laser pulse from the said resonant Fabry-Perot optical cavity.

MPEP § 2172.01 states:

“A claim which omits matter disclosed to be essential to the invention as described in the specification, or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See also MPEP 2164.08(c). Such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention.”

“In addition, a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968).” **(emphasis added)**

Applicants did not disclose in the specification of this application or in other statements of record that the steps identified by the Examiner are “essential.” Applicants believe that this section of the MPEP, and the cases cited, relate only to situations where the applicants have explicitly stated that an element or step is essential. Absent such a statement, Applicants believe

that this MPEP section does not apply, and that the rejection under 35 USC § 112 should be withdrawn.

The Examiner rejected Claim 27 due to a lack of antecedent basis for "said light." Applicants have amended Claim 27 to substitute "said optical radiation" for "said light." Optical radiation finds support in parent Claim 26, and thus withdrawal of this rejection is requested.

REJECTIONS UNDER 35 USC § 103

The Examiner rejected all of the pending claims as obvious in view of Jacobovitz-Veselka et al. combined with Hordvik. The Examiner acknowledges that Jacobovitz-Veselka et al. discloses a method of generating mode-locked Q-switched pulses, but lacks the step of suppressing Q-switching. The Examiner argues that Hordvik teaches the suppression of Q-switching. What is claimed here, and missing in either of the Examiner's references, is "A method of generating cw mode-locked laser pulses." Every claim in this application is related to the generation of cw pulses. Neither of the Examiner's references is related to cw pulses.

In fact, the Examiner admits that Jacobovitz-Veselka et al. lacks even the suppression of Q-switching. But more important is the fact that, though Hordvik teaches the suppression of Q-switching, it fails to teach the suppression of Q-switching to generate cw pulses. Hordvik teaches only a Q-switched laser with stretched pulses, not a cw laser in which the cw mode-locked energy is generated from Q-switched mode-locked pulses. It is the latter which is defined by the claims of this application, and Applicants believe that this invention is beyond any suggestion of either of the Examiner's references. Applicants request that the Examiner reconsider this rejection in view of the failure of the references, either solely or jointly, to suggest the generation of cw mode-locked energy from Q-switched mode-locked pulses.

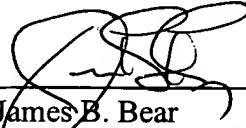
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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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